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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,304	10/15/2004	Takao Koyama	009682-138	9491
7590	12/11/2008		EXAMINER	
Robert G Mukai Burns Doane Swecker & Mathis PO Box 1404 Alexandria, VA 22313-1404			NGUYEN, TUAN N	
			ART UNIT	PAPER NUMBER
			3751	
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			12/11/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/511,304	<b>Applicant(s)</b> KOYAMA, TAKAO
	<b>Examiner</b> Tuan N. Nguyen	<b>Art Unit</b> 3751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 26 November 2008.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 21-60 is/are pending in the application.

4a) Of the above claim(s) 22-36,38-50,52,54,56 and 58 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 21,37,51,53,55,57,59 and 60 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments with respect to claims 21, 37, 51, 53, 55, 57 and 59 have been considered but are moot in view of the new ground(s) of rejection as indicated below.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 21, 37, 51, 53, 55 and 57 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification fails to teach how the ink guiding feed would provide a sign of exhausting the ink fed without allowing outside air flowing in equalizing the negative pressure as the ink is being used. Without such teaching, the ink will not dispense and the sign of exhausting the ink fed will not occur.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 21, 37, 51, 53, 55, 57, 59 and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 4,065,215 (herein Otsuka) in view of Takanashi et al. (as discuss in the previous office action, hereinafter Takanashi) and Madaus et al. (as discuss in the previous office action, hereinafter Madaus).

The Otsuka reference discloses a writing instrument (Fig. 1) having an ink occlusion body (16) as claimed; a pent tip (24a) including a capillary material (34a,34b) disposed in a writing part; and an ink guiding feed defined by a hollow tubular body (see Fig. 3). Although the Otsuka reference is silent as to the material of the barrel being made out of transparent material, attention is directed to the Takanashi reference which discloses an analogous writing instrument, which further includes a barrel (12) and an ink guiding feed (18) made out of transparent material (see col. 8, lines 11-16) so as to check not only the residual ink quantity in the ink tank but also that in the collector (see col. 5, line 64 et seq.). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the barrel of Otsuka out of transparent material as, for example, taught by Takanashi in order to check not only the residual ink quantity in the ink tank but also that in the ink guiding feed area. In so doing, a sign of exhausting the ink fed from the ink occlusion body is inherently detected by visually observing the ink guiding feed via a visible part formed in the barrel. In regard to claim 51, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make only a portion of the barrel visible as claimed in a way similar to the portion (10) in Fig. 4 of Madaus. In regard to claims 53, 55 and 57, although the Otsuka reference is silent of the specific dimension of the ink

guiding feed having an ink passage, the specific surface tension of the ink, and the specific viscosity of the ink as claimed, it would have been obvious to one of ordinary skill in the art at the time the invention was made to obtain an ink guiding feed having an ink passage cross-sectional area in the specific range as claimed and an ink having the specific surface tension and viscosity as claimed, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art.

***Conclusion***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Brunetti and Tefft disclose other writing instruments having hollow tubular ink guiding feed.
5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan N. Nguyen whose telephone number is 571-272-4892. The examiner can normally be reached on Monday-Friday (10:00-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Huson can be reached on (571) 272-4887. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Tuan Nguyen/  
Primary Examiner, Art Unit 3751

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